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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,720	01/06/2000	MING-SHIANG SHEN	STI-102	2061
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COOK MCFARRON & MANZO LTD 200 WEST ADAMS STREET SUITE 2850 CHICAGO, IL 60606				
		EXAMINER AKPATI, ODAICHE T		
		ART UNIT PAPER NUMBER		
		2131		

DATE MAILED: 10/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/478,720

Applicant(s)

SHEN, MING-SHIANG

Examiner

Odaiche T Akpati

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it exceeds 150 words in length.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 6 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Bjorn et al (6125192).

With regards to Claim 1, the limitation “a memory device for storing a data file and fingerprint reference data obtained by scanning a fingerprint of a person authorized to access the data file” is met on column 6, lines 31-33, 44-47. The combination of the storage unit and user data unit perform the same functions as the memory device in the invention.

The limitation “a fingerprint sensor adapted to scan a fingerprint of a user of said electronic data storage medium and to generate fingerprint scan data” is met on column 6, lines 28-30.

The limitation “an input/output interface circuit activable so as to establish communication with the data terminal” is met on column 6, lines 48-49, 55-57.

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The limitation “a processing unit connected to said memory device, said fingerprint sensor and said input/output interface circuit, said processing unit being operable selectively” is met on column 6, lines 19-26.

The limitation “a programming mode, where said processing unit activates said input/output interface circuit to receive the data file and the fingerprint reference data from the data terminal, and to store the data file and the fingerprint reference data in said memory device” is met on column 6, lines 31-33 and 44-47. The examiner asserts that the presence of the processes defined by the programming mode suggest the existence of a programming mode.

The limitation “a data retrieving mode, where said processing unit receives the fingerprint scan data from said fingerprint sensor, compares the fingerprint scan data with the fingerprint reference data in said memory device to verify if the user of said electronic data storage medium is authorized to access the data file stored in said memory device, and activates said input/output interface circuit to transmit the data file to the data terminal upon verifying that the user of said electronic data storage medium is authorized to access the data file stored in said memory device” is met on column 6, lines 28-43.

With regards to Claim 2, the limitation “a card body on which said memory device, said fingerprint sensor, said input/output interface circuit and said processing unit are mounted” is met on column 6, lines 19-27.

With regards to Claim 5, the limitation “wherein said processing unit stores the data file and the fingerprint reference data in said memory device in a compressed format” is met on

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column 5, lines 37-41 and column 7, lines 26-35. The examiner asserts that digitizing data is a form of data compression because the resulting data is reduced in size without the loss of pertinent information. Furthermore, "The Authoritative Dictionary of IEEE Standards Terms, Seventh Edition" defines data compression as 'any technique used to reduce the amount of storage required to store data.' Hence, the digitization of the scanned fingerprint data meets this definition.

With regards to Claim 6, the limitation "a function key set connected to said processing unit and operable so as to initiate operation of said processing unit in a selected one of the programming and data retrieving modes" is met on column 4, lines 13-14. The keyboard reads on this limitation because it possesses function keys that when selected, initiate a mode of operation. The programming and data retrieving modes are met on column 6, lines 31-33, 44-47 and column 6, lines 28-43 respectively.

With regards to Claim 11, the limitation, "a display unit connected to and controlled by said processing unit for showing the data file exchanged with the data terminal thereon" is met on column 4, lines 9-12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorn et al (6125192) in view of Jacobsen et al (2001/0043174 A1).

With regards to Claim 3, all the limitation is met by Bjorn et al except an independent power source for the electronic data storage medium.

The limitation "a power source mounted on said card body and connected to said processing unit for supplying electrical power thereto" is met by Jacobsen et al on page 8, paragraph 109.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jacobsen et al within the system of Bjorn et al because power is necessary for the running of the system.

With regards to Claim 4, Bjorn et al meets all the limitation except the existence of a flash memory device.

The limitation "memory device is a flash memory device" is met by Jacobsen et al on page 4, paragraph 109.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jacobsen et al within the system of Bjorn et al because a flash memory is a well known reliable form of non-volatile storage media.

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Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorn et al (6125192) in view of Fernando et al (6193152 B1).

With regards to Claim 7, Bjorn et al meets all the limitation except the limitation described in Claim 7.

The limitation "processing unit is further operable selectively in a data resetting mode, where the data file and the fingerprint reference data are erased from said memory device" is met by Fernando et al on column 2, lines 63-67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fernando et al within the system of Bjorn et al so as to prevent a malicious intruder from gaining access to the stored fingerprints.

With regards to Claim 8, the limitation "a function key set connected to said processing unit and operable so as to initiate operation of said processing unit in a selected one of the programming, data retrieving and data resetting modes" is partly met by Bjorn et al on column 4, lines 13-14, column 6, lines 31-33, 44-47, 28-43. Bjorn et al however does not discuss a data resetting mode. This is however disclosed by Fernando et al.

The data resetting mode is met by Fernando et al on column 2, lines 63-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fernando et al within the system of Bjorn et al so as to prevent a malicious attacker from gaining access to the stored fingerprints.

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Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorn et al (6125192) in view of Fernando et al (6193152 B1) in further view of Klebes (6321478 B1).

With regards to Claim 9, the combination of Bjorn et al and Fernando et al meet all the limitation except a password needed to initiate the resetting mode. This is however disclosed by Klebes.

The limitation “memory device further stores a reference password therein, said function key set being operable to provide an input password to said processing unit, said processing unit comparing the input password with the reference password and initializing operation in the data resetting mode upon verifying that the input password corresponds with the reference password” is met by Klebes on column 10, lines 12-19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Klebes with the combination of Bjorn et al and Fernando et al because a password will make the resetting mode more secure.

With regards to Claim 10, all the combination of Bjorn et al and Fernando et al meet all the limitation except the limitation of reset occurring after a preset time.

The limitation “processing unit automatically initiates operation in the data resetting mode upon detecting that a preset time period has elapsed since storage of the data file and the fingerprint reference data in said memory device” is met by Klebes on column 10, lines 12-19.

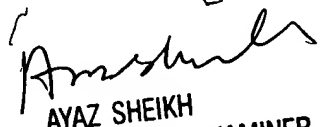
It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Klebes within the combination of Bjorn et al and Fernando et al so as to add security to the resetting mode.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Odaiche Tracey Akpati whose telephone number is 703-305-7820. The examiner can normally be reached on 8.30am-6.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7240 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

October 6, 2003


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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